

## **REMARKS/ARGUMENTS**

Applicants have carefully reviewed the Office Action mailed on March 25, 2008. Applicants respectfully traverse all objections, rejections, and assertions made by the Examiner. Claim 71 has been amended; claims 71-76 and 78-83 remain pending.

### **Claim Rejection under 35 U.S.C §102**

Claims 71-76, 79-81, and 83 were rejected under 35 U.S.C. §102(b) as being anticipated Mollenauer et al. (U.S. Patent No. 5,634,937). This rejection is respectfully traversed. Independent claims 71 and 80 each recite, "wherein the retractor is structured to remain in the expanded configuration when the expander is withdrawn from the access path." Mollenauer et al. do not appear to teach such a structure. The Examiner has not specifically addressed this element, but asserts that element 10 of Mollenauer et al. is considered as a retractor since it is capable for holding open the edges of the patient's body. Mollenauer et al. do not support this interpretation. Mollenauer et al. appear to teach a skin sleeve structured for insufflation, in which the sleeve provides a seal between a skin incision and instruments used in abdominal surgery when pressurized gas is injected into the abdomen to assist in the surgical procedure. See column 1, lines 54-67. Mollenauer et al. teach:

Where the cannula itself is made of a soft pliant material such as latex rubber or silicone rubber, the forceps may be manipulated even further, and deformation of the skin seal 28 will permit a wider range of motion for the forceps. Skin seal 28 is shown with a pair of conventional surgical scissors 31 or shears disposed through the skin seal. The scissors may be opened wide, as shown, and the distal or proximal end of the skin seal will yield and flare out to allow operation of the scissors through their full range of motion and opened through the full throw (the "throw" referring to the length of arc 35 over which the graspers or scissors may be opened) of scissors 31 or graspers, as illustrated by flared distal portion 36 of skin seal 28.

See column 8, lines 9-21 and FIG. 8. Mollenauer et al. appear to teach a soft, flexible skin seal 28 that expands and contracts to allow for movement of scissors 31. In order for the skin seal to function and maintain the desired sealing effect, the skin seal 28 would be expected to contract to a closed position when the scissors 31 are removed. The Examiner appears to be considering the scissors 31 as the claimed expander. However, the structure of the soft, pliant skin seal 28 taught by Mollenauer et al. does not appear to be structure to remain in an

expanded configuration when the scissors are withdrawn. Mollenauer et al. thus do not appear to teach the claimed structure.

If the Examiner is considering the specific retractor structure recited in the claims to be inherent in Mollenauer et al., Applicants submit that there is no basis for such an interpretation. MPEP 2112 IV. states:

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)...

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

(Emphasis added). Applicants submit that the claimed structure, in particular the retractor structured to remain in the expanded configuration when the expander is withdrawn from the access path, is not necessarily present in Mollenauer et al. It appears the Examiner is asserting that the structure of Mollenauer et al. could be modified to achieve the claimed structure, which is not a proper basis for an anticipation rejection.

Additionally, there is no motive for one of ordinary skill in the art to modify the structure of Mollenauer et al. to achieve the claimed structure because Mollenauer et al. appear to teach away from such a modification. As discussed above, Mollenauer et al. appears to teach their skin seal as functioning to provide a substantially air-tight seal between the skin incision and the instruments inserted through the seal. Applicants submit that modifying the skin seal of Mollenauer et al. such that the seal remained in an expanded configuration when instruments such as scissors 31 were removed would appear to cause the

“seal” to remain open. Such an open “seal” would appear to destroy the sealing properties of the skin seal, thus rendering the skin seal unsuitable for its intended use.

Mollenauer et al. fail to teach the structure recited in independent claims 71 and 80 and the claims dependent thereon. Reconsideration and withdrawal of the rejection are respectfully requested.

### **Claim Rejection under 35 U.S.C §103**

Claims 82 was rejected under 35 U.S.C. §103(a) as being unpatentable over Mollenauer et al. (U.S. Patent No. 5,634,937) in view Nwawka (U.S. Patent No. 6,036,638). This rejection is respectfully traversed. For at least the reasons set forth above, Mollenauer et al. fail to teach the elements of independent claim 80, from which claim 82 depends. Nwawka does not appear to teach or suggest what Mollenauer et al. lacks, thus even if one were to combine the teachings, one would not arrive at the system as claimed.

Additionally, the Examiner states as a reason for modifying Mollenauer et al. with Nwawka, “because one of ordinary skill in the art would have been able to carry out such a substitution, and the results were reasonably predictable.” Applicants submit that this is not a proper basis for obviousness. MPEP 2143.01 III states:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless \*\*>the results would have been predictable to one of ordinary skill in the art. *KSR International Co. v. Teleflex Inc.*, 550 U.S. \_\_\_, \_\_\_, 82 USPQ2d 1385, 1396 (2007)(“If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.”).<

Further, it is unclear how one would modify the skin seal of Mollenauer et al. to move along a slot as taught by Nwawka to lead to a pivot mechanism. Mollenauer et al. appear to rely on a soft, pliant, one piece design for the skin seal to provide the desired sealing properties. Thus, attempting to modify Mollenauer et al. to include a guide and slot would not provide predictable results. Reconsideration and withdrawal of the rejection are respectfully requested.

Reexamination and reconsideration are respectfully requested. It is respectfully submitted that the claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,  
Thomas W. Davison et al.

By their attorney,

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